Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-11, 16-18, 21-25, 27-31, 55-57, 61-63 and 66 are pending in the application, with 1, 31 and 55 being the independent claims. Claims 1, 16-18, 21-25, 27-29, 31, 55-56, and 61-63 are sought to be amended. Support for the amendments can be found in the original claims and throughout the specification, particularly at paragraph 46. No new matter has been added. Claims 12-15,19-20, 26, 58, 60, 64 and 65 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein.

In view of the above amendments and the following remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding objections and rejections.

Claim Rejections Under 35 U.S.C. § 102

Claims 1-18, 21-23, 25, 28-31, 55-59, and 61-63 were rejected under under 35 U.S.C. 102(b) as being anticipated by Jones (WO95/02049). Applicants respectfully disagree.

An anticipation rejection under 35 USC § 102 requires a showing that each limitation of a claim is found in a single reference, practice, or device. *See Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984). The present invention discloses a filtration apparatus comprising 2 filters (see specification at paragraph 46), with a first filter directly on top of a second filter so that the first filter is contacted with a sample (ie., biological macromolecules) before the

second filter. Jones discloses two filters separated by a conduit and a chamber (see Jones page 22 and corresponding figure 5; structures 46 & 49). Thus, the present claims are novel over Jones.

In view of the amendments and comments presented above, applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b).

Claim Rejections Under 35 U.S.C. § 103

Claims 19 and 24 were rejected under under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Dewitt (U.S. Patent 6,183,645). In addition, claim 20 was rejected under 35 U.S.C. 103(a) as being unpatentable over Jones as applied to claim 19 and 24 above, and further in view of Fung et al. (U.S. Patent 6,221,655); claims 26 and 27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Sirkar (U.S. Patent 5,053,132); and claims 24 and 60 were rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Fung *et al.* (U.S. Patent 6,221,655).

Establishing *prima facie* obviousness requires a showing that each claim element is taught or suggested by the prior art. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Specifically, establishing *prima facie* obviousness requires a showing that some combination of objective teachings in the art and / or knowledge available to one of skill in the art would have lead that individual to arrive at the claimed invention. *See In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Moreover, establishing *prima facie* obviousness requires not only that such a combination of prior art teachings is possible, but also that the teachings would have (a) motivated the skilled artisan to make the combination to arrive at the claimed invention, and (b) suggested to the skilled artisan a reasonable likelihood of success in making and using the claimed invention.

See In re Dow Chem. Co., 837 F.2d 469, 473 (Fed. Cir. 1988). Absent a showing of such motivation and suggestion, *prima facie* obviousness is not established. *See In re Fine*, 5 USPQ2d at 1598.

Independent claims 1, 31, and 55, and all claims dependent thereon, are novel in view of Jones, as Jones does not disclose a filtration apparatus comprising **2 filters with a first filter directly on top of a second filter.** None of the secondary references cure the deficiency.

In view of the amendments and comments presented above, applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a).

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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